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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/112,276	07/09/98	HO KEUNG	

HO KEUNG TSE
PO BOX 54670
NORTH POINT POST OFFICE
HONG KONG

TM02/1205

AIR MAIL

EXAMINER	
BARRON JR, G	
ART UNIT	PAPER NUMBER

2132

DATE MAILED:

12/05/00

12/05/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

File Copy

Office Action Summary

Application No.

09/112,276

Applicant(s)

HO KEUNG, TSE

Examiner

Gilberto Barron Jr.

Art Unit

2132

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**.
- 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claims ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some * c) ☐ None of the CERTIFIED copies of the priority documents have been:
1. ☐ received.
2. ☐ received in Application No. (Series Code / Serial Number) ____.
3. ☐ received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. & 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 18) ☐ Interview Summary (PTO-413) Paper No(s) ____.
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☒ Other: Forms

DETAILED ACTION

1. This case has been assigned to Group Art Unit 2132. Applicant is requested to use this designation on all papers filed.
2. The Amendment of February 2, 2000 added a new claim. This claim was numbered as claim 15. However, there was already a claim 15 present. In accordance with 37 CFR 1.126, this newly added claim is renumbered as claim 16. Applicant is requested to verify the renumbering and follow the renumbering in all responses filed.
3. The Amendment of February 23, 2000 added a new independent claim which has been renumbered as claim 16. The fee for the extra independent claim is \$40.00 US dollars. Applicant is requested to remit this fee with any response filed.
4. Applicant is also advised that any response requiring a further fee due will be held unresponsive until payment is made. A fee sheet is included with this action to aid Applicant in determining if a fee is due.
5. The Letter of September 23, 1999 requesting a delay in examination is not persuasive to delay the examination of this application. The appeal of the parent application may be pertinent to this examination, but it is not determinative. The examination of this application will proceed in accordance with normal examination process.
6. Applicant is requested to reconsider the appeal of parent application 08/578,448 as it appears that this application is, in effect, a continuation of the prosecution of the appealed claims and not a further application claiming a patentable distinguishable invention.

Drawings

7. The specification on page 3, provides a Brief Description of the Drawings, Figures 1 and 2. However, there were no sheets of drawings in the application papers filed July 9, 1998. If Applicant intends to submit such Figures now, Applicant is required to show that 1) NO NEW MATTER is being entered, and 2) the figures are the same as those provided for in the specification as filed. Applicant may simply state that the Figures are the same as those of the parent application, if such is the case.

Double Patenting

8. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

9. Claims 1-16 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-15 of copending Application No. 08/587,448. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1-16 of this application are only slightly broader than claims 1-15 of the parent application. The subject matter of claims 1-16 is obvious from the subject matter of co-pending parent application

claims 1-15, i.e. there does not appear to be any substantial difference between the claims in the parent application and this application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

10. A Terminal Disclaimer form is included herein if Applicant chooses to overcome this rejection by disclaimer.

Claim Interpretation

11. The instant claims are not in proper idiomatic English. Therefore for the purposes of this examination the claims are interpreted as a software protection system comprising the software to be protected, an identity software for providing information that enables operations that an authorized user is responsible for and an authorizing software module for determining the presence of the identity software module, and upon determining that the identity software module is present, permits the use of the software to be protected. The operation that the user is responsible for may be a payment operation. The authorization software module may also be used to authenticate the protected software, the identity module, the user computer, and/or the user.

Claim Rejections - 35 USC § 102

12. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

13. Claims 1, 2, 4, 7-11, 14 and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by Wiedemer (4,796,181)

The first patent to Wiedemer (4,796,181) discloses a billing system for computer software. Figure 1 shows the components of the billing system. This system meets the limitations of independent claims 1, 7, 10 and 14.

The SECURITY MODULE 16 corresponds to the recited Identity software. Column 6, lines 41-49 describes that the billing module provides information for enabling a billing operation to the user take place whenever the protected software is to be executed.

The Diskette start program shown in Figure 1 as part of element 14 corresponds to the recited authorizing software module. Column 5, lines 33-36, describes that the start program must verify the presence of the security module, i.e., the identity module.

The protected software will not be executed if the identity software, i.e. the billing module is not present, see column 2, lines 33-69.

The billing that takes place when the protected software executes in Wiedemer meets the recitation of the payment operation for which the authorized user is responsible for as per claims 4, 8, 11 and 15.

Claims 2 and 14 that recite the authentication of the identity software is met by the operation of checking that the external code and the internal code on the security module which are unique to any individual user are correct. See column 7, lines 15-46.

14. Claims 12, 13 and 16 are rejected under 35 U.S.C. 102(b) as being anticipated by Wiedemer (5,155,680).

The second Wiedemer patent (5,155,680) discloses a billing system similar to the first Wiedemer patent above and provides the same components. However, the variation of the billing system described in this patent also provides for PIN, i.e., password protection. Column 14, lines 40-43 describe that this correct information be provided from the user to allow the protected software to be executed as per claims 12, 13 and 15.

Claim Rejections - 35 USC § 103

15. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

16. Claims 3, 5 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wiedemer (4,796,181) in view of Cooper (5,737,416).

Claim 3 provides for the authorizing software module to authenticate the computer. While claims 5 and 6 provide for the protected software to include validating information for identity information and encrypted identity information. The identity information and the encrypted information are to be compared to determine validity of the protected software. Wiedemer does not describe the application information as providing the validation information or the authentication of the computer.

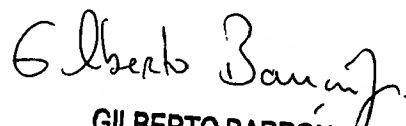
The Cooper patent is a system for allowing trial period use of software. The system provides protected software to be used if certain access conditions are met. Figure 32 shows that the system uses machine ID, including customer information to be

part of a file that must be present and validated for access to the protected software. Figure 24 shows that the protected software includes encrypted validation information for checking the integrity of the information used to determine validity. Column 20, lines 1-19 and col. 23, lines 3-16 describe the use of the machine ID to authenticate the computer and that use of the encrypted validity information to validate the identity information.

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gilberto Barrón Jr. whose telephone number is (703) 305-1830. The examiner can normally be reached on Mondays thru Thursdays from 8:00 AM to 5:00 PM. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Tod Swann, can be reached on (703) 308-7791. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-0040.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.


GILBERTO BARRÓN, JR.
PRIMARY EXAMINER
ART UNIT 222-2132